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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,965	09/26/2003	Eurell Thomas Eubanks	80021	3602

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EXAMINER

CHAN, SING P

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/672,965

Applicant(s)

EUBANKS ET AL.

Examiner

Sing P Chan

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) 22-46, 51-68, 71 and 72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21, 47-50, 69 and 70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/24/03 & 2/17/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-21, 47-50, 69, and 70, drawn to a method of blocking a stain on a substrate, classified in class 156, subclass 71.
  - II. Claims 22-46, 51-68, 71, and 72, drawn to a stain blocking composition, classified in class 428, subclass 40.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as printing the indicia onto the surface of the film and applying to an article as a label.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for Group I is not required for Group II, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Bernard Graves on October 29, 2004 a provisional election was made with traverse to prosecute the invention of group I, claims 1-21, 47-50, 69, and 70. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-46, 51-68, 71, and 72 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### **Claim Interpretation**

Regarding claims 1 and 69, it is noted in the Specification, the "stain" is recited to encompass holes, blemishes, cracks, and other minor surface imperfections. (See Specification, Page 9, lines 12-14)

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3-8, 69, and 70 are rejected under 35 U.S.C. 102(e) as being anticipated by Swanson (U.S. 6,607,621).

Regarding claims 1, 3-8, and 69, Swanson discloses a method of patching a wall. The method includes providing a dry film, removing the adhesive backing to expose the adhesive, applying the dry film over the stained or hole portion of the wall, pressing the patch to adhere the film to the wall, and painting the patch and wall. (Col 3, lines 38-45, Col 4, lines 2-11, and Col 5, lines 19-36)

Regarding claim 70, Swanson discloses the patch includes a feathered edge. (Col 3, line 66 to Col 4, line 11)

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson (U.S. 6,607,621) as applied to claim 1 above, and further in view of Reed et al (U.S. 3,432,376).

Regarding claim 2, Swanson as disclosed above is silent as to the dry film is supported on a release layer and the pressure applied to the dry film layer is provided through the release layer. However, providing a dry film is supported on a release layer and the pressure applied to the dry film layer is provided through the release layer is

well known and conventional as show for example by Reed et al. Reed et al discloses a method of dry transferring a dry film from a carrier sheet. The method includes providing thin transferable film carried by a carrier sheet, an adhesive layer on the thin transferable sheet, and a protective covering sheet on the adhesive layer, removing the protective sheet from the adhesive layer, applying the adhesive surface to the receiving surface, applying pressure through the carrier sheet, and pull away the carrier sheet, which is also used as a mask. (Col 2, lines 9-14 and Col 9, lines 3-10)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a dry transfer sheet as the dry film as disclosed by Reed et al in the method of Swanson to enable a user to transfer and cover the desired surface area with a dry film of any size and shape at the will of the user. (Col 1, lines 23-28)

Regarding claims 47-50, Swanson as disclosed above is silent as to the pressure is applied by hand, roller, spatula, or blade applicator uniformly across the surface of the dry film layer. However, applying pressure by hand, roller, spatula, or blade applicator uniformly across the surface of the dry film layer is well known and conventional as shown for example by Reed et al. Reed et al discloses the pressure is applied by needle stylus or knife or scribing tool or a ballpoint pen or radiused rod of metal wood or plastic, which is considered to be a roller and operated by hand. (Col 2, lines 25-45)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide needle stylus or knife or scribing tool or a ballpoint pen or radiused rod of metal wood or plastic, which is considered to be a roller and operated

by hand as disclosed by Reed et al in the method of Swanson to enable a user to transfer and cover the desired surface area with a dry film of any size and shape at the will of the user. (Col 1, lines 23-28)

10. Claims 9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson (U.S. 6,607,621) as applied to claim 1 above, and further in view of Shih et al (U.S. 5,891,294).

Swanson as disclosed above is silent as to the "stain" includes ink, crayon, lipstick, grease pencil, colored marker, smoke, water, tannin, hydrophilic stain, lipophilic stain, food residue, a dye, conjugated organic compound, an aromatic color body, a wood knot, mineral oil, petrolatum, or wax wherein the dry film layer prevent migration of the stain to the coating layers and prevent the coating layer from dissolving the stain. However, blocking stain with a dry film is well known and conventional as shown for example by Shih et al. Shih et al discloses a method of blocking stain with a barrier layer, which is a dry film. The method includes applying the film to the stain, which includes coated nail, ink marker, adhesive, pens, wood extractives, asphalt, driveway sealer, primers, shoe polish, or dyes onto a surface such as a floor or wall to prevent stain from diffusing to through the surface covering and would prevent liquid coatings from dissolving the stain. (Col 1, lines 21-26 and Col 2, line 64 to Col 3, line 7)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to block a stain with a dry film as disclosed by Shih et al in the method of Swanson to provide a stain blocking barrier to prevent the diffusion of stains

onto the surface covering, which prevent any undesired visual to the consumer. (Col 1, lines 16-20 and Col 1, lines 29-33)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Friday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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